REMARKS

Claims 1, 3-4, 7, 18-20, 22, 31, 33, 35, 43-44, 46-47 and 49-50 are currently pending in the subject application and are presently under consideration. Applicant's representative thanks the Examiner for the telephonic interview and notes that support for the limitations added to claims 1, 18, 31 and 33 can be found at p. 2, lines 18-29 and p. 5, lines 25-30 of the subject patent application. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 3-5, 7, 18-20, 22, 31, 33-35, 43, 44, 46, 47, 49 and 50 Under 35 U.S.C. §103(a)

Claims 1, 3-5, 7, 18-20, 22, 31, 33-35, 43, 44, 46, 47, 49 and 50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McCollom, US Patent 6,925,444 ("McCollom") in view of Spiegel, US Patent 6,629,079 ("Spiegel") and further in view of Fergerson, US Patent 5,966,697 ("Fergerson"). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither McCollom nor Spiegel nor Fergerson, either alone or in combination, teach or suggest all of the limitation of the claims.

> The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a ***whole*** would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); *see also e.g.*, *In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (*See In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (*See Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344,

> 61 U.S.P.Q.2d at 1434). If the PTO relies on multiple prior art references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (*See In re Dembiczak*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *see also In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of coming forward with evidence or argument shift to the applicant. (*See In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

McCollom discloses a wish list that a user can send to another consumer so that the other consumer can purchase items for the user (*i.e.*, a gift registry). (*See* McCollum at col. 2, lines 30-26, col. 3, lines 2-8 and col. 24, line 55- col. 25, line 10). Neither McCollom nor Spiegel nor Fergerson, either alone or in combination, teach or suggest a component that allows one or more ***merchant servers*** to access ***a list on the user's computer*** and ***place items corresponding to the list into the shopping basket component***. For at least the foregoing reasons, the cited prior art fails to render obvious the claimed subject matter as a whole. Accordingly, applicant's representative respectfully requests that this rejection be withdrawn.

II. Rejection of Claims 4 and 19 Under 35 U.S.C. §103(a)

Claims 4 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McCollom in view of Spiegel in view of Fergerson and further in view of Call, US Patent 6,154,738 ("Call"). Claims 4 and 19 depend from claims 1 and 18, which, as explained above, are patentable over McCollom in view of Spiegel in view of Fergerson. Call fails to remedy the aforementioned deficiencies of McCollom, Spiegel and Fergerson. For at least the foregoing reasons, the cited prior art fails to render obvious the claimed subject matter as a whole. Accordingly, applicant's representative respectfully requests that this rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP140US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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